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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,062	07/30/2001	Keith Alexander Harrison	30006786-2	2570

7590 01/13/2005

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EXAMINER

DAVIS, ZACHARY A

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/918,062	HARRISON ET AL.	
	Examiner	Art Unit	
	Zachary A Davis	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 July 2001.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-19 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20010730</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Authenticating Facsimile Documents Using Digital Signatures.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-12 and 14-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Linsker et al, US Patent 5598473.

In reference to Claims 1, 5, and 8, Linkser discloses a method for determining the authenticity of a fax document (column 2, lines 23-27) that includes receiving a document and a digest of the document created by a hash algorithm and encrypted with a first token, which is the sender's private key (column 4, lines 54-60, where digest signature DS is the encrypted digest); obtaining a second token, which is the sender's public key, relating to the private key (column 4, lines 57-65); decrypting the digest with the public key (column 5, lines 20-23); creating a second digest using a hash algorithm (column 5, lines 23-27, and column 4, lines 25-35); and comparing the decrypted received digest with the second created digest (column 5, lines 23-42).

In reference to Claims 2 and 3, Linsker further discloses receiving a digital certificate of the sender and that the public key is part of the certificate (column 5, lines 2-13).

In reference to Claim 4, Linsker further discloses checking the validity of the certificate online (column 5, lines 6-13).

In reference to Claims 6 and 7, Linsker further discloses printing the document with a verifying mark once it has been authenticated (column 6, lines 3-29).

In reference to Claims 9, 10, and 17, Linsker discloses a method of sending a fax document (column 2, lines 23-27) that includes creating a digest of the document using a hash algorithm (column 4, lines 25-35); encrypting the digest with a first token, which is the sender's private key (column 4, lines 40-47); obtaining a second token, specifically the sender's public key, that will be used to decrypt the encrypted digest;

and sending the encrypted digest, the document, and the public key to the recipient (column 4, lines 50-53).

In reference to Claims 11 and 12, Linsker further discloses proving the sender's identity by transferring data from a personal portable data carrier holding the private key to the transmission station from the document will be sent, and that the sender enters a verifiable security identifier to establish the sender's identity (column 7, lines 13-21).

In reference to Claims 14-16, Linsker further discloses obtaining details of the sender, including the public key, from a central database, and providing the details and public key in a digital certificate (column 4, lines 50-53; column 5, lines 2-13).

Claims 18 and 19 are apparatus claims corresponding substantially to the methods of Claims 1 and 9, and are rejected by a similar rationale.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linsker in view of Clark, US Patent 5448045.

Linkser discloses everything as applied above in reference to Claim 11.

However, Linsker does not explicitly disclose that the digest is encrypted within the personal portable data carrier. Clark discloses that digital signatures (formed by encrypting a message digest with a private key) can be performed in smart cards (column 8, lines 53-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Linkser to include encrypting the digest within the personal portable data carrier, in order to prevent compromise of the sender's private key (see Clark, column 8, lines 57-62).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Menezes et al, US Patent 5473691, disclose a system in which a digital signature may be used to determine authenticity of fax transmissions.
- b. Le Corre et al, US Patent 5555307, disclose a fax machine with a security device that can calculate and verify digital signatures.
- c. Newman, US Patent 5671285, discloses a fax machine that combines a digital signature with the sent message.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A Davis whose telephone number is (571) 272-

3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER